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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,070	05/03/2001	Kenny K. Fok	UTL00015	7836
32968 7590 09/27/2006 KYOCERA WIRELESS CORP. P.O. BOX 928289 SAN DIEGO, CA 92192-8289			EXAMINER DANIEL JR, WILLIE J	
			ART UNIT	PAPER NUMBER
			2617	
DATE MAILED: 09/27/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/848,070	FOK, KENNY K.	
	Examiner	Art Unit	
	Willie J. Daniel, Jr.	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 50-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment filed on 30 January 2006. **Claims 50-63** are now pending in the present application and **claims 1-49** have been canceled. This office action is made **Final**.

Claim Objections

2. **Claim 54** is objected to because of the following informalities:
 - a. Claim 54 recites the limitation "...of claim 2..." in line 1 of the claim. The Examiner interprets as "...of claim 52..." since claim 2 has been canceled.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The 112 rejections of claims 27, 34-35, 37-38, and 44 are withdrawn since the claims have been canceled.

Specification

4. The disclosure is objected to because of the following informalities:
 - a. Applicant states "ref. 200" in the instant application amended paragraph for pg. 10, line 11. This change has not been marked as being amended. Examiner interprets as "ref. 300" which refers to Fig. 3.

Appropriate correction is required.

Regarding applicant's comments in the remarks section on pg. 7-8, item C, "...believes no further amendment is required...", the Examiner respectfully disagrees. Applicant has amended specification since the original filing, but failed to properly correct errors. Therefore, applicant has the responsibility and duty to properly correct or amend errors. See MPEP § 714 and 37 CFR 1.121 (b) and (e).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 50-63 are rejected under 35 U.S.C. 102(e) as being anticipated by **Carey et al.**

(hereinafter Carey) (**US 6,714,793 B1**).

Regarding **claim 50**, Carey discloses a system (20) for providing a mobile unit device (36) which reads on the claimed "wireless communications device" access to an instant messaging service on a data network (30), the instant messaging service communicating instant messages in an instant message format (see col. 3, lines 18-49; Figs. 1, 5-6), the system (20) comprising:

a wireless mobile carriers (34) which reads on the claimed "wireless network", the wireless communications device (36) establishing an active state on a wireless network (34) (see col. 6, lines 26-32, 52-60; col. 3, lines 45-49; col. 7, lines 19-29; Figs. 1, 5, 9-10, and 12);

a short message service (SMS) center (32) connected to the wireless network (34) (see col. 3, lines 18-34; col. 5, lines 23-43; Figs. 1, 5-6);

a IM routing system (22) which reads on the claimed “proxy server” having a first connection to the SMS center (32) and a second connection to a data network (30) (see col. 3, lines 18-34; col. 5, lines 23-43; Figs. 1, 5, and 6),

the proxy server (22) for establishing a substitute proxy presence on the data network (30) for the wireless communications device (36) (see col. 5, lines 5-18; col. 6, lines 12-60; col. 4, lines 11-19; Fig. 5), where the user presence is established between networks,

the proxy server (22) for transmitting presence information to the instant messaging service to indicate that the wireless communications device (36) is online as long as the wireless communications device (3) is in the active state (see col. 3, lines 18-34; col. 5, lines 23-43; Figs. 1 and 5-6),

the proxy server (22) for intercepting and storing an instant message addressed to the wireless communications device (36) (see col. 9, lines 35-38; col. 5, lines 66-67; Fig. 1), where the combined functions of the routing system (22) and the instant message server (40) would provide the storing of instant messages; and

a plurality of traditional systems (42) which reads on the claimed “information handling systems” connected to the data network (30) and logged into the instant messaging service for sending and receiving the instant messages (see col. 3, lines 18-34; col. 4, lines 6-11; Fig. 1).

Regarding **claim 51**, Carey discloses the system of claim 50, wherein the proxy server notifies the SMS center (32) that the instant message addressed to the wireless communications device (36) has been received (see col. 7, lines 8-18; Fig. 6).

Regarding **claim 52**, Carey discloses the system of claim 50, wherein the proxy server (22) converts at least a portion of the intercepted instant message to a short message format, and sends a converted message to the wireless communications device (36) through the wireless network (34) via the SMS center (32) (see col. 7, lines 12-22; col. 3, lines 24-27,50-66; Figs. 1 and 6-7), where the server (24) uses a predefined to protocol to convert messages between instant message and short message service.

Regarding **claim 53**, Carey discloses the system of claim 50, wherein the proxy server (22) converts an identifier (e.g., name, phone number, or address) of a sender of the intercepted instant message to a short message format and sends the converted identifier of the sender to the wireless communications device (36) (see col. 7, lines 12-22; col. 5, lines 43-50; col. 8, lines 19-21,32-40; col. 3, lines 24-27,50-66; col. 4, lines 11-33; Figs. 1, 6-7, and 9-10), where the server (24) uses a predefined to protocol to convert messages between instant message and short message service.

Regarding **claim 54**, Carey discloses the system of claim 52, wherein the SMS center (32) stores the converted message (see col. 7, lines 27-29; Fig. 7 “ref. 172”).

Regarding **claim 55**, Carey discloses the system of claim 50, wherein the proxy server (22) receives a response short message from the wireless communications device (36) that is addressed to an information handling system of the plurality of information handling systems (42), converts the response short message to an instant message format response

message, and sends the instant message response message to the information handling system (42) (see Figs. 1 and 6-7).

Regarding **claim 56**, Carey discloses the system of claim 50, wherein the proxy server (22) receives an indication that the wireless communications device (36) is in an inactive state, and wherein the proxy server removes the substitute proxy presence upon receipt of the indication that the wireless communications device (36) is in the inactive state (see col. 7, lines 44-64; col. 8, line 61 - col. 9, line 5; Figs. 7 “ref. 174”, 12).

Regarding **claim 57**, Carey discloses a method for providing a wireless communications device (36) access to an instant messaging service connected to a data network (30) (see Fig. 1), the method comprising the steps of:

communicating an active message state status from the wireless communications device to a wireless network, wherein the wireless network is connected to a short messaging service (SMS) center, the SMS center is connected to a proxy server (22), and the proxy server (22) is connected to the data network (30) (see col. 3, lines 18-34; col. 5, lines 23-43; Figs. 1 and 5-6);

the proxy server (22) establishing a stand-in on-line presence for the wireless communications device with the instant messaging service (see col. 5, lines 5-18; col. 6, lines 12-60; col. 4, lines 11-19; Fig. 5), where the user presence is established between networks;

the proxy server (22) maintaining the stand-in on-line presence as long as the wireless communications device remains in the active message state status (see col. 3, lines 18-34; col. 5, lines 23-43; Figs. 1 and 5-6); and

the proxy server (22) intercepting and storing at least one instant message intended for the wireless communications device (36) (see col. 9, lines 35-38; col. 5, lines 66-67; Fig. 1), where the combined functions of the routing system (22) and the instant message server (40) would provide the storing of instant messages.

Regarding **claim 58**, Carey discloses the method of claim 57 further comprising the steps of:

the proxy server (22) converting at least a portion of the at least one instant message to short message service (SMS) format (see col. 7, lines 12-22; col. 3, lines 24-27,50-66; Figs. 1 and 6-7), where the server (24) uses a predefined to protocol to convert messages between instant message and short message service;

sending the converted message to the SMS center (32) (see col. 7, lines 12-22; col. 3, lines 24-27,50-66; Figs. 1 and 6-7), where the server (24) uses a predefined to protocol to convert messages between instant message and short message service;

the SMS center (32) sending the converted message to the wireless network (34) (see col. 7, lines 12-22; col. 3, lines 24-27,50-66; Figs. 1 and 6-7); and

the wireless network (34) delivering the converted message to the wireless communications device (36) (see col. 7, lines 12-22; col. 3, lines 24-27,50-66; Figs. 1 and 6-7).

Regarding **claim 59**, Carey discloses the method of claim 57, further comprising the step of:

the proxy server (22) notifying the wireless communications device (36) through the SMS center (32) and the wireless network (34) that the at least one instant message has been received (see col. 7, lines 8-18; Fig. 6).

Regarding **claim 60**, Carey discloses the method of claim 59, wherein the step of notifying comprises the steps of:

the proxy server (22) converting at least a portion of the at least one instant message from instant message format to short message service (SMS) format (see col. 7, lines 12-22; col. 3, lines 24-27,50-66; Figs. 1 and 6-7); and

sending the converted message to the wireless communications device through the SMS center (32) (see col. 7, lines 12-22; col. 3, lines 24-27,50-66; Figs. 1 and 6-7).

Regarding **claim 61**, Carey discloses the method of claim 60, further comprising the step of:

the proxy server (22) converting an identifier of the sender of the at least one instant message from the instant message format to SMS format (see col. 7, lines 12-22; col. 5, lines 43-50; col. 8, lines 19-21,32-40; col. 3, lines 24-27,50-66; col. 4, lines 11-33; Figs. 1, 6-7, and 9-10); and

sending the converted identifier to the wireless communications device (36) (see col. 7, lines 12-22; col. 5, lines 43-50; col. 8, lines 19-21,32-40; col. 3, lines 24-27,50-66; col. 4, lines 11-33; Figs. 1, 6-7, and 9-10).

Regarding **claim 62**, Carey discloses the method of claim 58, further comprising the steps of:

the wireless communications device (36) sending a response message transmitted in short message service format to the proxy server (22) (see Figs. 1 and 6-7); and

the proxy server (22) converting the response message to instant message format and transmitting the converted response message over the data network (30) (see Figs. 1 and 6-7).

Regarding **claim 63**, Carey discloses the method of claim 58, further comprising the steps of:

the proxy server (22) receiving a delivery status of the converted message from the wireless network (34) (see Figs. 1, 3-7, and 10-12);

the proxy server (22) utilizing the delivery status to determine that the converted message is undeliverable to the wireless communications device (36) (see Figs. 1, 3-7, and 10-12);

and

the proxy server (22) establishing an offline presence with the instant messaging service to indicate that the wireless communications device (36) is offline (see Figs. 1, 3-7, and 10-12).

Response to Arguments

6. Applicant's arguments filed 30 January 2006 have been fully considered but they are not persuasive.

The Examiner respectfully disagrees with applicant's arguments as the applied reference(s) provide more than adequate support and to further clarify (see the above claims and comments in this section).

7. Regarding applicant's comments in the remarks section on pg. 7-8, item C, "...believes no further amendment is required...", the Examiner respectfully disagrees. Applicant has amended specification since the original filing, but failed to properly correct errors. Therefore, applicant has the responsibility and duty to properly correct or amend errors. See MPEP § 714 and 37 CFR 1.121(b); 37 CFR 1.121(e).
8. Regarding applicant's comments in the remarks section on pg. 7-8, item D, "...*proxy server*...substitutes for the wireless communication device on an **Instant Messaging (IM) network**...", the Examiner requests clarification. The Examiner requests applicant to provide support (i.e., page(s), line(s), and drawing(s)) of the element(s) that represent the **instant messaging service** provided in the claim language.
9. The Examiner requests applicant to provide support for any further amended claim language.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Willie J. Daniel, Jr. whose telephone number is (571) 272-7907. The examiner can normally be reached on 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information

Art Unit: 2617

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/WJD,JR/

WJD,JR
24 September 2006


ERIKA A. GARY
PRIMARY EXAMINER